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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,574	10/06/2003	Joel Sloan	34261-8600	3138

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EXAMINER	
BURCH, MELODY M	
ART UNIT	**PAPER NUMBER**
3683	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,574	Applicant(s) SLOAN ET AL.	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-10,14,15,17,20-23 and 25-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-10,14,15,17,20-23 and 25-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/06 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25, 27, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification failed to provide support for the limitation of "resilient buckling" as recited in the claims. See the discussion of the phrase "resilient buckling" in paragraph 7 of the instant Office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-6, 8-10, 14-15, 17, 20-23 and 25-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5110660 to Wolf et al.

Re: claims 1, 2, 4, 5, 6, 9, 14, 15, 17, 20, 21, 22, 23, and 25-31. Wolf et al. show in figure 3 a multi-axis and vibration isolator comprising: a body having a top end and a bottom end, the body made of an elastomeric material as disclosed in col. 4 lines 14-15 for attenuating at a first frequency along a vertical axis that passes through the top and bottom ends, a first hole shown to the left of the hole labeled with element 6 extending through the body between the top and bottom ends and a second hole shown to the right of the hole labeled with element 6 extending through the body between top and bottom ends, the second hole intersecting the first hole, the first and second holes being sized and shaped for attenuating vibration at a second frequency along a lateral axis as suggested in col. 2 lines 49-53.

Also with respect to the size and shape of the holes, Examiner notes that In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration is significant. Examiner notes that it is old and well-known in the art to modify the cross-section of an openings or apertures within a vibration isolator to achieve the attenuation of certain desired frequencies.

Re: claim 8. Wolf et al. show in figure 3 a third hole or the hole to the left of the end of the lead line of number 7 extending through the body along a third axis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration is significant. Applicant lacks criticality for the recitation of the shape of the holes specifically being circular. In fact, Applicant teaches away from the particular configuration being significant by suggesting in the last line of pg. 6 and the first line of pg. 7 that the holes can be circular *or other shapes*.

Response to Arguments

8. Applicant's arguments filed 9/14/06 have been fully considered but they are not persuasive.

Applicant argues that Wolf does not read on the claims because Wolf's spring dampens loads "without buckling" and that the present invention "intentionally buckles" so that it may dampen loads. First, Examiner notes there is no indication that the device in Wolf dampens "without buckling" generally across the board as suggested by Applicant. Instead, the cited section of Wolf states that when loads are applied specifically "*at right angles* to the planes of the groups of channels" there is no shown buckling effect in the spring characteristics. Second, there is nothing in the claim language or in the originally filed specification that indicates that the present invention "intentionally buckles" to dampen loads.

Applicant adds parallel claims that recite "resilient buckling" as well as "resilient displacement". The claims appear to be structured in a way to suggest that "buckling" and "displacement" are intended to be synonymous (although it is certainly possible to have displacement without having buckling, Applicant is allowed to be his own lexicographer). It is clear from the originally filed specification that the isolators in the instant application move while accomplishing their attenuating function. Therefore, if Applicant intends for "buckling" and "displacement" to be used interchangeably, then the originally filed specification provides adequate support for the recitation, and the Wolf reference still reads on the claim since even when the load is imposed at right angles to the planes of the channels of the isolator, the isolator of Wolf still experiences movement at least through reaction forces. On the other hand, if Applicant intends for "buckling" and "displacement" to have different meanings (for example, buckling being defined as a collapse due to a certain amount of displacement), then the originally filed specification lacks proper support for the added limitation, and the Wolf reference still reads on the claims since it is disclosed that buckling in Wolf is generally not a consequence *only* when the load is imposed at *right angles* to the plane of the groups of channels.

Applicant also argues that Wolf is not a multi-axis shock absorber. Applicant bases the statement on the fact that only force F1 acting downward in the z-direction is shown. Examiner notes that the illustration and discussion of a force acting in one direction does not preclude the presence of other forces acting in other directions. Examiner maintains that a force acting in the x-direction or the y-direction would also be absorbed to a certain extent by virtue of the presence of the elastomeric material along those axes. Applicant further argues that there is "no suggestion in Wolf to configure a spring to absorb loads incident on multiple axes." Examiner disagrees and notes that the most persuasive suggestion is the resemblance in structure between the isolator of Wolf and that of the instant invention. Both devices include a body of elastomeric material with a plurality of holes symmetrically oriented in the body. The device of the instant invention has been described as being configured to absorb loads incident on multiple axes. Since the device of Wolf has a similar structure, it is too configured to absorb loads incident on multiple axes.

Finally, Applicant argues that Wolf "teaches away" from using his spring to absorb lateral loads. First, Examiner notes that the force illustrated in figure 2 is a lateral force from the perspective of a person facing the device in the location of the phrase "Fig. 2". Second, Examiner notes that the "question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d, 1354,1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Accordingly, the rejections have been maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
September 26, 2006

Melody M. Burch
Melody Burch
Primary Examiner
9/26/06